

## **REMARKS**

The Applicant has canceled Claims 12 and 48 and amended Claims 1, 7, 13, 16, 20, 26, 30, 34, 35, 38, 41, 58-60, and 65, which are supported by the original specification.

## **OBJECTIONS TO THE SPECIFICATION**

The Examiner has objected to Claims 66 and 67 as lacking support in the specification for reciting “upon user request”. The Applicant respectfully disagrees and directs the Examiner to paragraph [0014] in which the Applicant describes a user initiated event as, “a request from a user of the first client to transfer the license to the second client (or revoke the license of the first client and to create a license for the second client)”. The Applicant respectfully requests that the Examiner withdraw this objection.

## **REJECTIONS OF THE CLAIMS UNDER §102**

The Examiner has rejected Claims 1, 7, 8, 12, 20, 22, 23, 26, 27, 30, 34, 38, 41, 47, 48, 52, 55, and 58-67 under 35 U.S.C. §102(b) as being unpatentable over Inoue, U.S. Patent Application No 2003/0028622. The Applicant respectfully asserts that the Inoue reference does not teach or suggest each and every element of Claims 1, 7, 8, 20, 22, 23, 26, 27, 30, 34, 38, 41, 47, 52, 55, and 58-67.

In particular, Inoue does not teach “allowing an initial set of permissible actions on the first client with the electronic file, regardless of a connection between the first client and the server” of Claims 41, 47, 52, and 55, or “transferring a first license to the first client that allows a first set of licensed actions on the first client with the electronic file” of Claims 26, 27, 30, 34, 38, and 58-67. Paragraph [0037] of Inoue states: “The content distribution center 2 distributes a content, which cannot be used on its own, in response to a content request for content distribution from the user.” Inoue teaches away from allowing an initial set of permissible actions.

Additionally, Inoue does not include: “*allowing a first set of licensed actions by the first client with the transferred electronic file based on the first license regardless of a connection between the first client and the server*” of Claims 1, 7, 8, 20, 22, and 23. Inoue

describes a system for permitting usage of content by ticket requests. A ticket request as described by Inoue includes “a content ID of a content the user wishes to use” (Inoue, paragraph [0039]). The use of a ticket response is as described in paragraph [0045]: “In response to a ticket request, the management server 5 judges whether the ticket request is made by the child terminal 7. If not, the management server 5 issues, to the terminal making the request, a license ticket that enables playback of the requested content under certain usage rules. When judging that the request is made by the child terminal 7, the management server 5 attaches additional usage rules, which are provided in advance according to a request from the parent terminal 6, to a usage range so as to produce a new license ticket for the child terminal 7, and issues it to the requesting terminal.” The system described by Inoue would require a network connection between the child terminal and/or adult terminal and the management server for content to be used since a terminal must issue a ticket request with information for content the user wishes to use through the network. This teaches away from the system of the Applicant. The system of Inoue regulates usage of terminals through a network and is not for a licensing method for an electronic file. This is further supported by the abstract of Inoue that describes the system as “A management server (5) manages usage rules in accordance with which terminals use contents”. Inoue does not teach each and every element of the applicant.

For these reasons, the Applicant respectfully requests that the Examiner reconsider and withdraw these rejections under §102.

### **REJECTIONS OF THE CLAIMS UNDER §103**

The Examiner has rejected Claims 13, 16, 35, and 49 under U.S.C. §103(a) as being unpatentable over Inoue, U.S. Patent Application No. 2003/0028622 in view of Barber, U.S. Patent No. 5,390,297. The Applicant respectfully asserts that the Examiner has not established a *prima facie* case because the references do not teach or suggest each and every element of these claims.

In particular, Inoue in view of Barber does not teach or suggest “requesting a dummy file ... and ... receiving the dummy file” as in Claims 13 and 49, or “transferring an empty license” of

Claims 16 and 35.

Barber does not teach the use of an electronic dummy file or the transferring of an empty license file. As stated in Barber Col. 11 lines 4-9 “The license manager 25A then takes path 49 to a step 50 that causes the operating system 15 at the local node 14 to create a new empty license file 22A on the local node 14 at which it is desired to use the copy of the computer program 24A”. However, this empty license file is created on the local node and not transferred.

In Col. 11 lines 1-2 Barber states “The license 27 so transferred is referred to as a ‘transferred license’”. The applicant asserts that the license 27 of Barber is not an empty license nor is license 27 described as an empty license being transferred. Prior to this statement, Barber states, “If the license 27 in the license file 22A on the second remote node 20 has not expired, is not in use and is valid, a ‘no’ path 47 is taken to a step 48. *The step 48 is the first step in the transfer of the license 27 to the local node 14.* The license 27 so transferred is referred to as a ‘transferred license’. *In step 48, the license manager 25A causes the license 27 to be stored in the system memory 16 at the local node 14.*” As can be seen from this excerpt, the step 48 describes the step of transferring a license, and this step 48 is also described as storing the license 27 in system memory at the local node. This license 27 is not an empty license since prior to that Barber checks if the license has expired and if it is in use, thus it must have content. Thus, Barber does not teach or suggest the transferring of an empty license to the first client.

For these reasons, the Applicant respectfully requests that the Examiner reconsider and withdraw these rejections under §103.

## CONCLUSION

In view of the preceding amendments and remarks, the Applicant respectfully submits that the specification is in order and that all of the claims are now in condition for allowance. If the Examiner believes that personal contact would be advantageous to the disposition of

this case, the Applicant respectfully requests that the Examiner contacts the Attorney of the Applicant at the earliest convenience of the Examiner.

Respectfully submitted,

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